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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,976	10/16/2003	Mark Russell Attieh	0073/65994	8950
7590 Richard FJaworski Cooper & Dunham 1185 Avenue of the Americas New York, NY 10036				
EXAMINER				
WINTER, JOHN M				
ART UNIT		PAPER NUMBER		
3685				
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10/04/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/937,976

Applicant(s)

ATTIEH, MARK RUSSELL

Examiner

JOHN M. WINTER

Art Unit

3685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 52-54, 57-59, 61, 63, 65 and 67-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 52-54, 57-59, 61, 63, 65 and 67-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/3508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. The Applicants appeal filed on February 22, 2010 is hereby acknowledged, Claims 52-54, 57-59, 61, 63, 65 and 67-72 remain pending. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Response to Arguments

2. Applicant's arguments with respect to the pending claim have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 52-54, 57-59, 63 and 67-70 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

4. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a § 101 process must (1) be tied to a particular machine or apparatus (machine implemented); or (2) particularly transform a particular article to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed. In this particular case, claim 52 fails prong (1) because the “tie” (e.g. communication device) is representative of extra-solution activity. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing. Claims 53-54,57-59,63 and 67-70 are either dependant upon claim 52 or contain similar limitations and are rejected for at least the same reasons.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 52-54, 57-59, 61, 63, 65 and 67-72 rejected under 35 U.S.C. 112, first paragraph, because in regard to claim 52, the specification does not reasonably provide enablement for linking the first terminal identifier of a first communication device to a first account number. The specification does not enable any person skilled in the art to which it pertains, or with

which it is most nearly connected, to use the invention commensurate in scope with these claims.

Claims 53-54, 57-59, 61, 63, 65 and 67-72 are either dependant upon claim 52 or contain similar limitations and are rejected for at least the same reasons.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 52-54, 57-59, 61, 63, 65 and 67-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gallagher et al. ('608) in view of Tan et al (US Patent 7,716,129) in view of Randle et al. (US Patent 5,974,146).

7. As per claims 52, 59, 61 and 67-72,

Gallagher et al. ('608) discloses a method for conducting financial transactions comprising:
providing an intermediate database (Figure 1, element 22)

providing an intermediate database computer for controlling the intermediate database,(column 7 line 66 –column 8, line 14)

information identifying a second account and an amount requested to be paid from the first account to the second account;

Gallagher et al. ('608) does not explicitly disclose linking a first terminal identifier of a first communication device to a first account number of a first account; storing the linked first terminal identifier and the first account number in the intermediate database within receiving from the first communication device via a communication network, information identifying a the first terminal identifier of the first communication device, accessing the intermediate database and using the first terminal identifier of the first communication device to obtain the first account number; Tan et al. ('129) discloses linking a first terminal identifier of a first communication device to a first account number of a first account; storing the linked first terminal identifier and the first account number in the intermediate database within receiving from the first communication device via a communication network, information identifying a the first terminal identifier of the first communication device accessing the intermediate database and using the first terminal identifier of the first communication device to obtain the first account number; (Column 2, line 37- column 17; Column 7, lines 39-64, column 9, lines 24-36) . It would be obvious to one having ordinary skill in the art at the time of the invention to combine Gallagher et al. ('608)'s system with Tan et al's teaching in order to limit the prosecution of fraudulent transactions.

8. Gallagher et al. ('608) does not explicitly disclose accessing the intermediate database and using the first terminal identifier of the first communication device and obtaining the first account number; using the first account number to communicate a signal that interrogates the first account and determines whether sufficient funds are available in the first account to effect payment; and when it is determined that sufficient funds are available, debiting the first account and crediting the second account and when it is determined that insufficient

funds are available, canceling the transaction. Randle ('146) discloses accessing the intermediate database and using the first terminal identifier of the first communication device and obtaining the first account number; using the first account number to communicate a signal that interrogates the first account and determines whether sufficient funds are available in the first account to effect payment; and when it is determined that sufficient funds are available, debiting the first account and crediting the second account and when it is determined that insufficient funds are available, canceling the transaction. (column 10, lines 31-41-- Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See e.g. MPEP §2106 II C: "Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.] " As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Gallagher et al. ('608)'s system with Randle ('146)'s teaching in order to limit the prosecution of fraudulent transactions.

9. As per claim 53,

Gallagher et al. ('608) discloses the method of claim 52

Gallagher et al. ('608) does not explicitly disclose conducting the financial transaction on a real time, on-line basis. Randle ('146) discloses conducting the financial transaction on a real time, on-line basis..(column 7, lines 10-20) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Gallagher et al. ('608)'s system with

Randle ('146)'s teaching in order to provide an efficient service to the customer.

10. As per claim 54,

Gallagher et al. ('608) discloses the method of claim 52

wherein the first account number is a first bank account number, the first account is a first bank account, the second account number is a second bank account number .(Column 6, lines 21-44, column 7, lines 29-52)

11. As per claim 55,

Gallagher et al. ('608) discloses the method of claim 52

further comprising linking the second terminal identifier to the second account number in the intermediate database (column 7, lines 29-52)

12. As per claim 56,

Gallagher et al. ('608) discloses the method of claim 52

Official Notice is taken that “wherein the second terminal identifier of a second communication device” is common and well known in prior art in reference to electronic transactions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a terminal identifier as a device identifier in order to uniquely identify a client.

As per claim 57,

Gallagher et al. ('608) discloses the method of claim 52

Wherein the first communication device is a cellular telephone. (column 4, lines 46-53)

13. As per claim 58,

Gallagher et al. ('608) discloses the method of claim 52

further comprising communicating the fact of the transaction to the first communication device. (Column 7, lines 29-65)

As per claim 59,

14. Gallagher et al. ('608) discloses the method of claim 56

communicating the fact of the transaction to the second communication device. (Column 5, lines 36-60)

15. As per claim 63,

Gallagher et al. ('608) discloses a method for conducting financial transactions according to claim 52,

Gallagher et al. ('608) does not explicitly disclose canceling the transaction when it is determined that sufficient funds are not available. Randle ('146) discloses canceling the transaction when it is determined that sufficient funds are not available. (column 10, lines 31-41) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Gallagher et al. ('608)'s system with Randle ('146)'s teaching in order to limit the prosecution of fraudulent transactions.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMW

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685